

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Broderick <i>et al.</i>	Conf. No.:	4352
Serial No.:	10/042,625	Art Unit:	3623
Filing Date:	01/09/2002	Examiner:	Deshpande, Kalyan K.
Title:	A PROJECT MANAGEMENT METHOD FOR OPTIMIZING INFORMATION TECHNOLOGY RESOURCES	Docket No.:	FR920000074US1 (IBME-0252)

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a *prima facie* case of obviousness based on an error in facts. Claims 1-8 are pending in this application.

Turning to the rejection, in the Final Office Action, 1-8 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996 (hereafter “Alter”). Applicants submit that this rejection is clearly not proper and without basis because at least one claim limitation is not met by the combined features of the references cited by the Office. As argued in the April 3, 2006 Amendment, the cited references fail to teach or suggest each and every element of independent claim 1. In particular, Alter fails to teach or suggest

consolidating the IT sites of the geographic area by considering project cost parameters and geographic site location peculiarities. April 3, 2006 Amendment, page 7, first full paragraph. The Office admits that Alter does not explicitly teach this limitation, but instead attempts to extrapolate consolidation of IT sites from an alleged teaching of Alter, of "...applying cost-benefit analysis for the project and accounting for commonly overlooked costs regarding hardware and site preparation such as re-wiring a site." Final Office Action, page 4. To this extent, the Office's statement applies to accounting for overlooked costs in *existing* sites such as re-wiring of *existing* sites. As such, the Office's statement does not support consolidation of (e.g., possible elimination of) existing sites. Thus, the Office's statement amounts to Official Notice and the Office should be required to submit references that support this feature.

As further argued in the April 3, 2006 Amendment, Alter also fails to teach or suggest determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area. See April 3, 2006 Amendment, page 6, beginning of section C through page 7, end of continued paragraph. In contrast, Alter does not teach or suggest that its data centers, which the Office equates with the number of IT sites of the claimed invention, are determined according to a pre-defined business process need. Stated differently, even though the data centers of Alter may be distributed, Alter does not teach or suggest the manner in which the data centers are determined, much less that they are determined according to a particular pre-defined project business need. Furthermore, although Alter teaches assigning roles to specific personnel, it does not teach that the personnel are determined according to a pre-defined project technical need.

As still further argued in the April 6, 2006 Amendment, there is no motivation or suggestion in Alter for modifying it to perform the task indicated by the Office's Official Notice. For example, while Alter deals with investing in systems, the claimed invention provides for, *inter alia*, consolidation of sites. To this extent, there would be no expectation that the system investing system of Alter could achieve success if used in a site consolidation environment. Furthermore, Alter specifically states that "...there is no ideal formula for deciding which systems and capabilities to invest in," and as such, does not suggest a method having formulaic processes for optimizing IT sites (e.g., by consolidation) to achieve a cost savings.

Accordingly, the Office has failed to state a *prima facie* case of obviousness, and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

The dependent claims are believed to be allowable based on the above arguments regarding the claims from which they depend, as well as for their own additional features.

Applicant respectfully submits that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Date: February 12, 2007

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